

### **REMARKS**

The present application relates to inbred maize plant and seed PH0GC. Claims 1-30 are pending in the present application. Claims 19-22, 25-28 and 30 have been amended as previously allowed by Examiner Kruse in U.S. Serial No. 10/767,558. No new matter has been added by way of amendment. Applicant respectfully requests consideration of the claims in view of the following remarks.

#### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 19-24 and 28-29 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. *See* Office Action, pp. 2-3.

The Examiner states that claims 19-24 are indefinite "because the specification does not teach that an inbred maize line having all of the morphological and physiological characteristics of PH0GC as comprising a single locus conversion, a transgene or comprising a gene conferring male sterility". *See* Office Action, p. 3.

Applicant respectfully traverses this rejection. Claims 19 and 23-24 depend from claim 11, which is adequately described and enabled. Claim 11 has been deemed allowable by the Examiner. Although not acceding to the Examiner's rejection, in an effort to expedite prosecution Applicant has amended claim 19 to read "single gene conversion", further defining the claims. Applicant further submits that the terms "single gene conversion" and "single locus conversion" are synonymous and would be well understood by one of ordinary skill in the art. Applicant respectfully submits that one skilled in the art would thus recognize that Applicant has adequately defined claims 19 and 23-24.

Further, the Specification teaches that a gene conferring male sterility can be introduced into a maize plant using techniques well known in the art. (*See* Specification, pp. 2-3 and p. 21) One skilled in the art would thus recognize that Applicant has adequately described claims 23 and 24.

The Examiner further states that claims 28 and 29 remain indefinite "because they incorporate all elements of claim 11." *See* Office Action, p. 3.

Applicant traverses this rejection. Claims 28 and 29 are definite and do include the plant of allowable claim 11 wherein the plant is "[a] maize plant having all the physiological and

morphological characteristics of inbred line PH0GC, wherein a sample of the seed of inbred line PH0GC was deposited under ATCC Accession Number PTA-4523". In addition, claims 28 and 29 claim the maize plant of claim 11 with additional limitations, which are not necessarily present in the maize plant of claim 11. The presence of these additional limitations does not mean that claims 28 and 29 do not possess all limitations of claim 11; these claims still require a maize plant having the physiological and morphological characteristics of inbred line PH0GC. Because claims 28 and 29 do incorporate all elements of claim 11, it is in accordance with the requirements of § 112, second paragraph. While not acquiescing to the Examiner's arguments, Applicant has amended claims 28 and 29 as previously allowed by the Examiner in U.S. Serial No. 10/767,558. Further, Applicant respectfully asserts that Applicant is aware that in view of a meeting with the Group Director in July 2006, the Examiner's were informed that the present claim set, including claims 28 and 29, were in proper form and would be allowable as has been evidenced in analogous Pioneer Hi-Bred Int'l, Inc. inbred continuation cases. Therefore, Applicant asserts the claims are consistent with allowable claims and respectfully request this rejection be alleviated.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

#### **Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 19-24 and 27 remain rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner states "Applicant does not describe maize line PH0GC as comprising a single locus conversion, a transgene or comprising a gene conferring male sterility" ... "the maize plants of claims 19-24 are not adequately described because the 'single locus conversion' would/could produce a broad genus of morphological and physiological characteristics that differ substantially from inbred line PH0GC". The Examiner further states claim 27 "fails to adequately describe derived inbred lines". See Office Action, pp. 3-4.

Applicant respectfully traverses this rejection. The relevant claimed subject matter in claims 19-24 and 27 is the plant of *allowed* claim 11 comprising a transgene or gene conversion.

The specification teaches multiple ways of introgressing or transforming a maize plant with various genes which confer advantageous traits desired in the plant. *See* specification, pp. 28-35. The specification also teaches many transgenes that could be inserted into the plant of claim 11. *See* specification, pp. 28-33. In addition, see U.S. Patent No. 5,936,145, issued August 10, 1999, which is prior to the filing date of the instant application. Claim 39 reads as follows: "[t]he single gene conversion of the corn plant of claim 29, where the gene confers enhanced yield stability." Thus, a single gene that confers enhanced yield stability was known in the art prior to the filing date of the instant application. One of skill in the art would recognize that it is common to transform a maize plant with various genes in order to confer desired traits to the maize plant.

Furthermore, Applicant reiterates that the written description requirement of § 112, first paragraph has been fulfilled by depositing seeds of PH0GC in a public depository and by referencing the deposit in the specification. *See* specification, p. 40; *see also Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 965, 63 U.S.P.Q.2d 1609, 1613 (Fed. Cir. 2002) (stating that the written description requirement of § 112, ¶ 1 may be fulfilled by depositing material in a public depository, where the deposited material is not accessible in writing, and where reference to the deposit is made in the specification). This deposit not only describes inbred maize line PH0GC but also the hybrid maize plants, plant parts, and seeds grown in claims 19-24 and 27.

In addition, in an effort to reduce the issues upon appeal, Applicant respectfully asserts that Applicant is aware that in view of a meeting with the Group Director in July 2006, the Examiner's were informed that the present claim set, including claims 19-24 and 27, were in proper form and would be allowable as has been evidenced in analogous Pioneer Hi-Bred Int'l, Inc. inbred continuation cases. While not acquiescing to the Examiner's arguments, Applicant has amended claims 19-22 and 27 as previously allowed by the Examiner in U.S. Serial No. 10/767,558. Therefore, Applicant respectfully requests this rejection be alleviated.

One skilled in the art would recognize that Applicant has fully described and fully satisfied the legal standards of written description for claims 19-24 and 27 as of the filing date of the application. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §112, first paragraph.

**Summary**

Applicant acknowledges that claims 1-18, 25 and 26 are allowed.

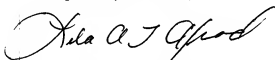
**Conclusion**

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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